

**REMARKS**

Applicants respectfully request that the finality of the rejection currently of record be withdrawn until the Examiner places it into a condition that can be reasonably deciphered by Applicants and by the Board, given the engineering reality that the references currently of record are clearly based on entirely different techniques. The rejection of record extracts words and concepts from these disparate techniques even though various of these extracted features clearly cannot even be incorporated into the technique used in primary reference Naccache, let alone be incorporated without either changing its principle of operation or defeating its purpose.

However, should the Examiner wish to defend the rejection currently of record on Appeal, entry of this Amendment is also proper under 37 CFR §1.116, since no new claims or issues are raised and since the only claim amendments address the rejection under 37 CFR §112, first paragraph, by incorporating the wording from line 19 of page 17 of the specification relative to recording the initial reading, thereby reducing the issues for appeal.

It is noted that, notwithstanding any claim amendments made herein, Applicants' intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1, 3, 4, and 7-53 are all of the claims pending in the present Application. Claims 4, 8-41, and 45 stand rejected under 35 USC §112, first paragraph, as failing the written description requirement.

Claims 1, 3, 4, 7, 8, 19-23, 25-33, 38-40, 43, and 47 stand rejected under 35 USC §103(a) as unpatentable over US Patent 5,434,917 to Naccache et al., further in view of US Patent 5,974,150 to Kaish, and further in view of US Patent 6,543,685 to Lien et al., and further yet in view of US Patent 5,426,700 to Berson.

Claims 34-36 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, and further in view of Berson. Claims 44, 52, and 53 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, and further in view of US Patent 6,131,090 to Basso et al. Claim 9 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, further in view of Berson, and further in view of US Patent 5,949,881 to Davis.

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Claims 10 and 11 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, further in view of Berson, further in view of Davis, and further in view of US Patent 6,297,888 to Noyes et al. Claims 12 and 13 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, further in view of Berson, and further in view of US Patent 6,297,888 to Noyes et al.

Claims 14 and 37 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, further in view of Berson, and further in view of US Patent 6,155,605 to Bratchley et al. Claim 41 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, further in view of Berson, and further in view of Basso.

Claim 45 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, further in view of Berson, and further in view of US Patent 5,257,389 to Liu et al. Claim 46 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, and further in view of Noyes.

Claim 48 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, and further in view of US Patent 6,233,339 to Kawano et al. Claim 49 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, and further in view of US Patent 6,155,605 to Bratchley et al.

Claim 51 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, further in view of Lien, and further in view of US Patent 3,795,805 to Swanberg et al.

Applicants gratefully acknowledge the Examiner's indication that claim 50 would be allowable if rewritten in independent format and, as appropriate, in a manner that overcomes the rejection under 35 USC §112, first paragraph. It is noted that the rejection currently of record is contradictory as to the status of claims 15-18 and 24, since paragraphs 18 and 19 indicate that these claims would also be allowable, but the listing in (7) of the summary sheet does not support this status. Moreover, Applicants believe that all the claims are allowable.

Therefore, these rejections are respectfully traversed in view of the following discussion.

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## I. THE CLAIMED INVENTION

As described and claimed, for example by claim 39, the present invention is directed to a method of guaranteeing authenticity of an object that includes or has attached thereto at least one of a chip with a recording support and another recording support.

Attached to the object is a first sample of material obtainable by at least one of a chemical process and a physical process having a characteristic that samples generated by the process are random and non-reproducible. The first sample is associated with a first number obtained by reading the first sample using a first reader of a specific sort.

A representation of the first number is recorded on at least one of the recording supports at said time of production in an exactly readable way, so that the first number can be checked against a later reading made with any reader of the specific sort at each time of verification of the object, thereby providing a first verification that verifies that a sample being read at the verification of the object is indeed the first sample.

At the time of production, at least one encrypted version of the first number is formed. At least one of the encrypted versions of the first number is also recorded in an exactly readable way on the object at the time of production. The at least one encrypted version of the first number is obtained by a method from public key cryptography. The recording of the at least one encrypted version thereby provides a second verification that verifies at the verification that the encrypted version of the first number was generated by an authorized party.

Information concerning the public key cryptography method is available so that the second verification can be made by anyone of an intended public.

The rejection currently of record attempts to use isolated bits and pieces from a large number of prior art references to reconstruct the combinations of elements defined in the claimed invention. However, Applicants submit that, not only does such evaluation approach violate the "as a whole" requirement of 35 USC §103, as discussed in MPEP §2141.02 ("*In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.*"), but that the primary reference Naccache is disqualified to

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serve as a primary reference by reason that it fails to satisfy the plain meaning of the language of the independent claims requiring affixation to an object, since it teaches the entirely different concept that the object itself being protected (e.g., the plastic card) is itself the random-sample object, rather than the plastic card as being affixed to the object being protected.

## II. THE REJECTION BASED ON 35 USC §112, FIRST PARAGRAPH

Claims 4, 8-41, and 45 stand rejected as failing the written description requirement because the Examiner considers that the description in claims 33-36 and 39, wherein is described the recording of the unencoded version of the number in addition to the encoded version, lacks support in the specification.

As best understood, the Examiner considers that the description at lines 18-19 on page 17 of the specification, related to the description of items 105, 107 in Figure 1, fails to "... specify as to whether or not the item is encrypted; therefore, it cannot be specifically claimed as being "unencrypted," "unencoded," or "uncoded;" it is also noted that, in claim 36, the coded and uncoded numbers are recited as being on the same medium; items 105 and 107 are different media."

In response, Applicants have amended claims 33-36 and 39 consistent with the wording from the specification. It is noted, however, that Applicants' claim amendments are not intended as in any manner surrendering or limiting the engineering reality of the reader used to read the sample. That is, as clearly described in various places of the specification, the reader will provide an output number as a result of its operation of scanning the sample. Whether that number is represented in 1's and 0's, as groups of 1's and 0's, as bytes of data, as a digital representation, where "digital" means a format expressed in 1's and 0's or more generally as a representation in any number base, the precise format is irrelevant.

If, as the Examiner seems to suggest, the number from a reader cannot be described as "unencrypted", "unencoded", or "uncoded", Applicants submit that they do not intend to limit the present invention as to any characterization about the format of the number provided as an output of the reader. The specification clearly describes that the reader provides a number representing a reading of the sample and that, in one embodiment of the present invention, that

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number output from the reader is recorded on the object to be protected as an output number provided by the reader, in addition to a recording of the number as being further processed by an additional encoding or encryption process. It is noted that Applicants intend the claim language to mean that the number being recorded as output from the reader means that the number being recorded is a number in whatever format the reader has been designed to output a reading.

Therefore, Applicants submit that the original disclosure does indeed contain the required written description of this embodiment. As Applicants have explained, the motivation for this embodiment is that of allowing the raw reading of each new scan of the sample to be cursorily checked for accuracy with the raw reading of the original scan, whatever format that reader uses for its output of the scanning.

Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

### III. THE PRIOR ART REJECTIONS

#### III A. Introduction

Applicants again submit that the rejections currently of record fail to meet the initial burden of a *prima facie* rejection for at least the following two reasons that have not yet been addressed on the record. Applicants request that the Examiner properly address these two issues prior to proceeding to Appeal.

1. Primary reference Naccache teaches the use of a plastic card having therein-embedded random marbles. This plastic card is clearly not affixed to (or attached to) an object being protected, thereby clearly failing to satisfy the plain meaning of the language of at least independent claims 1, 39, 42, and 52, that very clearly requires that the random sample be affixed to the object being protected.

Until the rejection of record addresses this basic deficiency, it clearly fails to meet the initial burden of a *prima facie* rejection.

2. Recently-cited secondary reference Berson fails to satisfy the plain meaning of the claim limitation of the feature upon which the Examiner relies. That is, the Examiner introduces

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Berson as demonstrating the writing of an unencoded version of the sample affixed to the object, as indicated by the rejection for claims 1, 3, 4, 7, 8, 19-23, 25-33, 38-40, 42, 43, and 47 contained in paragraph 4 beginning on page 3 of the Office Action, for claims 34-36 contained in paragraph 5 beginning on page 7, for claim 9 contained in paragraph 7 beginning on page 12, for claims 10 and 11 contained in paragraph 8 beginning on page 13, for claims 12 and 13 contained in paragraph 9 beginning on page 14, for claims 14 and 37 in paragraph 10 beginning on page 15, for claim 41 contained in paragraph 11 on page 16, and for claim 45 in paragraph 12 beginning on page 16.

However, the "information" described at lines 23-27 of column 6 of Berson fails to satisfy the plain meaning of the claim language wherein it is required that the unencrypted information is the reading of the scanner. Berson makes no suggestion whatsoever of recording the raw data from a scanner, unless the Examiner wishes to rely upon the image of the person being scanned. However, this person's image, the output of the reader, clearly fails to be a sample such as used in primary reference Naccache, nor does the image scanned satisfy the plain meaning of the claim language that a number be recorded, as representing output of the reader. For this reason alone, Berson does not overcome the deficiencies conceded by the Examiner to be present for those claims for which this recently-cited secondary reference is introduced.

### III B. Applicants' Responses to the Examiner's Arguments

Until preparing the Appeal Brief, Applicants do not wish at this time to expend the many hours of time it will take to explain why the disparate techniques of the many secondary references cannot be incorporated into the technique of primary reference Naccache. Suffice it to say at this point that a number of the disparate techniques will clearly change the principle of operation of this primary reference or will even defeat the purpose of the plastic card of Naccache, both results of which are prohibited by the holdings described in MPEP §2143.01.

That is, it is brought to the Examiner's attention that everything in the rejections is based upon starting out with Naccache as the primary reference and that the burden of the Office is to modify Naccache in accordance with the claimed invention. As explained in MPEP §2143.02, part of the evaluation includes a reasonable expectation of success of the modification/

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combination of Naccache, and this aspect of the modification includes a proper evaluation of the engineering reality of both the primary reference Naccache and the respective secondary references. The rejections currently of record merely take words out of the context and engineering reality of primary reference Naccache and is not in any way based on the reality of this primary reference.

However, prior to proceeding to Appeal, Applicants do respond below to various responses in the section entitled **Response to Arguments** beginning on page 21 of the Office Action, as indicating to the Examiner that the legal basis for his position are not at all supported by the sparse wording taken from case holdings that do not share the facts of the present application.

First, relative to the Examiner's reliance on *In re Gorman*, wherein the Examiner relies upon the phrase "... *reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention*", Applicants submit that the "without more" aspect of this phrase is being ignored by the Examiner. The rejections of record merely extract words out of the context of the primary reference Naccache, thereby attempting to completely re-construct this primary reference.

Second, relative to the Examiner's reliance on *In re Keller*, wherein the Examiner relies upon the phrase "... *one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references*", Applicants submit that these words in this holding does not in any way eliminate the burden on the Examiner of the initial burden for a *prima facie* rejection. Indeed, Applicants suggest that the Examiner read this case before attempting to use this phrase again in a response in an Office Action, since they are not intended in the manner that Examiners attempt to use this phrase.

The facts of *Keller* are not present in the prosecution of the present application, and this phrase cannot be taken out of the context of the facts of the *Keller* case. In *Keller*, these words are used because an affidavit filed by that applicant addressed only one of the two references cited by the Examiner and failed to address the second and more important reference. Thus, these words apply because the applicant in that case failed to address the second reference; they are not used in the context that the present Examiner intends, that an applicant is precluded from attacking that the combination of references is improper.

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Third, relative to the Examiner's reliance on *Amgen*, enablement of a patent does not mean that the patent will still perform its intended purpose when modified by a secondary reference.

Fourth, relative to the Examiner's reliance on US Patent No. 5,581,257 for embedding metal fiber in plastic, primary reference Naccache does not suggest using metal fibers in place of its marbles nor does secondary reference Kaish suggest using plastic in place of its cloth or of using metal fibers in lieu of its woven fibers. Again, the Examiner's burden begins with a reasonable basis to modify primary reference Naccache to use the woven fibers used in secondary reference Kaish. The rejection of record merely presumes that any and all possible modifications are inherently obvious but does not provide any reasonable justification for that modification.

Moreover, Applicants point out that modifying Naccache to use fibers rather than marbles would not address the basic deficiency of Naccache that the plastic card is not affixed to an object.

Fifth, relative to the Examiner's response on page 23 of the Office Action for claim 31, the issue for Appeal is not whether attaching documents into rigid plastic is well known. Rather, the issue is whether the rejection of record has provided a reasonable motivation to modify primary reference Naccache.

Sixth, relative to the Examiner's response on page 23 of the Office Action for the combination of Naccache with Lien, Applicants submit that the Examiner's rationale is clearly based upon recognizing that a modification can be made. This motivation is improper under MPEP §2143.01: "*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.*" (emphasis in MPEP itself) If a magnetic strip is placed on the plastic card of Naccache having marbles embedded therein, then it is clear that the magnetic strip will interfere with the detection of the marbles underlying that magnetic strip.

Seventh, relative to the Examiner's response on page 23 of the Office Action for the modification of Naccache by incorporating the woven fibers of secondary reference Kaish, Applicants submit that principle of operation of primary reference Naccache would have to change, since it is based upon detecting steel marbles, not woven fibers. Such change in the

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principle of operation is improper under MPEP §2143.01: *"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."*

Eighth, relative to the Examiner's response on page 23 for claim 42, contrary to the Examiner's characterization, this claim describes a statistical processing that is more than an "appropriate reader."

Ninth, relative to the Examiner's response on page 24 for claims 19, 26-29, and 38, contrary to the Examiner's reliance on *Ex parte Obiaya*, the issue is whether the Examiner's initial burden has been met. There would have to be reasonable motivation to modify primary reference Naccache.

Tenth, relative to the response for claims 20, 21, and 30, Applicants submit that the plain wording of the claim language has not been addressed in the rejection of record.

Eleventh, relative to the response for claim 32, the Examiner's response merely confirms that the rejection fails as a matter of law, since the modification is not to the primary reference Naccache.

Twelfth, relative to the response for claim 37, the Examiner would have to demonstrate a reason to add the manufacturing date to a card such as used in Naccache. For example, credit cards do not have their date of manufacture placed on them.

Thirteenth, relative to the response concerning Davis, Basso, Kawano, and Swanberg, the Examiner's justifications are improper to establish that these references are analogous.

#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 3, 4, and 7-53, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

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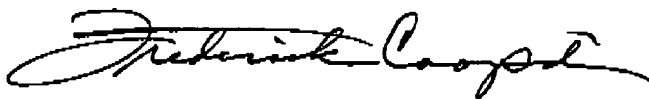
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Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: 8/16/06



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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 this Amendment under 37 CFR §1.116 to Examiner M. Heneghan on August 16, 2006.



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